

**REMARKS**

This Amendment is filed in response to the Office Action mailed November 21, 2005 and the telephonic interview with Examiner Mazzuca of January 30, 2006. In this Amendment, the Applicant has amended claim 1 to include the subject matter of claim 4, amended claim 5 to be dependent upon claim 1, amended claim 6 as discussed below and amended claim 10 as also discussed below. In the telephonic interview of January 30, 2006, Examiner Mazzuca stated that paragraph 9 of the Office Action incorrectly stated that "Claim 1 and 11 would be allowable if rewritten" and should have stated that "Claim 10 and 11 would be allowable if rewritten or amended" to overcome the rejection under 35 U.S.C. § 112, 2<sup>nd</sup> paragraph, discussed below. Thus, this Amendment is filed based upon the correction of paragraph 9 of the Office Action.

Claims 1 through 11 were rejected by the Examiner under 35 U.S.C. § 112, 2<sup>nd</sup> paragraph, based upon the use of the phrase "substantially simultaneously" in claims 1, 6 and 10. As noted by the Examiner, this phrase is unclear in the context of these claims. The Applicant agrees and claims 1 and 10 have been amended to recite "and performing the following steps *substantially simultaneously*" which is the original meaning of the use of this phrase in the independent claims.

Claim 1 was rejected as anticipated under 35 U.S.C. § 102(b) by U.S. Patent No. 3,446,908 of *Tally, et al*. However, the Patent Office Action indicated that claims 4 and 5 would be allowable if rewritten to overcome the rejection under 35 U.S.C. § 112, 2<sup>nd</sup> paragraph, and to include all of the limitations of the base claim and any intervening claims. Thus, claim 1 has been amended to include the subject matter of claim 4, claim 4 has been cancelled and claim 5, which was dependent upon claim 4, has been amended to be dependent upon claim 1. Therefore, the Applicant respectfully submits that claims 1 to 3 and 5 are in condition for allowance based upon the office action.

Claim 6 was rejected as unpatentable under 35 U.S.C. § 103(a) over the *Tally, et al.* reference in view of U.S. Patent No. 5,237,733 of *Ladouceur, et al.* The Applicant respectfully traverses this rejection on the following grounds. First, the *Tally, et al.* patent discloses a printed circuit terminal and method of making a printed circuit terminal which includes inserting a soft copper tube 16 through an opening 14 in a printed circuit board including outer insulation layers 11 and 12 and an inner conductive layer 13. The soft copper tube may be deformed as shown in Figures 5, 7, etc. to deform or roll over the distal ends of the soft over the insulation layers 11 12 as shown for example in Figure 7. However, in Figure 6, “in the central portion thereof, there is seen a finished eyelet 72, which has the solid tube 73 gripping the electrical conductor 26.” (Col. 5, lines 73-75). However, the eyelet 72 is not a “self-attaching female fastener element” as defined in the claims and it would certainly not be obvious to combine the teaching of the *Ladouceur, et al.* patent with the disclosure of the *Tally, et al.* patent because the *Tally, et al.* patent is *unrelated art*. That is, the *Ladouceur, et al.* patent, which is assigned to the assignee of the predecessor in interest of this application, discloses a fastener and panel assembly generally as disclosed, for example, in U.S. Patent No. 4,831,698 cited in the Information Disclosure Statement and also assigned to the predecessor in interest of the assignee of this application.

That is, the *Ladouceur, et al.* patent discloses a self-attaching *fastener* for attaching a component or element to a panel to which the fastener is attached. Modifying the *Tally, et al.* patent to include the features of the *Ladouceur, et al.* patent would be specifically *contrary to the teaching* of the *Tally, et al.* patent, which discloses an eyelet and a method of attaching an eyelet to a circuit board.

As the Examiner is aware, there must be the “rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references” to avoid “hindsight-

based obviousness.” In *Re: Sang Su Lee*, 277 F.3d 1338 (Fed. Cir. 2002). There is certainly no teaching or motivation to combine the teaching of the *Ladouceur, et al.* patent with the *Tally, et al.* patent and the proposed combination would actually defeat the purpose of an eyelet of a circuit board.

For example, as set forth in claim 6, the self-attaching female fastener element includes a body portion “having a threaded bore therethrough” and tubular barrel portions on opposed ends of the body portion “having an outer diameter less than an outer diameter of said body portion.” The method of claim 6 further requires driving the open distal end of either of the tubular barrel portions against the panel “piercing an opening in said panel.” Obviously, there is no body portion in the tubular soft copper eyelet disclosed in the *Tally, et al.* patent and it would certainly not be obvious to a person of ordinary skill in this art to use one of the ends of the soft copper tubular eyelet to pierce an opening in the panel as taught by the *Ladouceur, et al.* patent. As noted in the specification of this application, one problem with the type of fastener disclosed in the *Ladouceur, et al.* patent is the fact that the fasteners having a tubular barrel portion must be aligned in the installation head prior to installation. By including identical tubular barrel portions projecting from opposed ends of the body portion each having the same longitudinal length avoids having to align the fastener in the installation head prior to installation because either end may be driven into the panel to pierce a panel opening. This concept is also *contrary to the teaching of the Ladouceur, et al. patent*. Claim 6 as amended further recites that the second tubular extends through the open distal end tubular barrel portion formed when the body portion is driven into the panel surrounding the panel opening. *None of the cited references disclose or suggest this method step*. Claim 6 also recites the claims deforming the first end of the tubular open ends radially outwardly and inwardly to entrap an open distal end of the tubular

barrel portion *of said panel* which is deformed into the panel "surrounding said body portion" as defined in claim 6. Finally, the method of claim 6 recites "deforming a second of said tubular ends of an other of said tubular barrel portions *spaced above a plane of said panel* radially outwardly and inwardly *toward said body portion* to reduce the longitudinal length of said female fastener element installed in said panel."

These limitations of Claim 6 are contrary to the teaching of both references. Obviously, the *Tally, et al.* patent does not disclose or suggest a fastener element having a body portion and including tubular barrel portions on opposed ends of the body portion having a diameter less than the body portion. In fact, neither reference discloses or suggests a self-attaching fastener of this type. Neither of the references disclose driving the body portion of the fastener into the panel to form a tubular panel portion with the a tubular barrel portion projecting through an open end of the panel portion. Further, the ends of the soft copper tubular eyelet of the *Tally, et al.* patent are not deformed radially outwardly and inwardly to reduce the *axial length* of the eyelet. Thus, the Applicant respectfully submits that claim 6 defines over the prior art.

Finally, claim 10 has been amended to overcome the rejection under 35 U.S.C. § 112, 2<sup>nd</sup> paragraph, as discussed in the telephone interview and, therefore, claims 10 and 11 are also in condition for allowance. Claims 12 to 14 have been cancelled as directed to a non-elected invention subject to the filing of a divisional application.

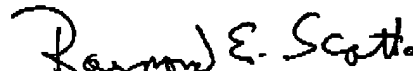
The Applicant therefore respectfully submits that the claims in this application are now in condition for allowance and allowance is respectfully requested.

Although it is believed that no fee is due for the filing of this Amendment, the Commissioner is authorized to charge our Deposit Account No. 08-2789 for any additional fees or credit the

account for any overpayments regarding this Amendment. Further and favorable reconsideration of the outstanding Office Action is hereby requested.

Respectfully submitted,

**HOWARD & HOWARD ATTORNEYS, P.C.**



Raymond E. Scott, Reg. No. 22,981  
The Pinehurst Office Center, Suite 101  
39400 Woodward Avenue  
Bloomfield Hills, Michigan 48304-5151  
Telephone: (248) 723-0306

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**CERTIFICATE OF FACSIMILE TRANSMISSION**

I hereby certify that the attached **Response to Election/Restriction Requirement** for Serial No. 10/691,847 is being facsimile transmitted to the Commissioner for Patents and Trademarks, Alexandria, Virginia, to the attention of **Examiner Douglas Mazzuca, Jr.** from **Group: 3726** to facsimile number (571) 273-8300 on February 6, 2006.



Tracy L. Smith

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